

REMARKS

Claims 1, 6 and 7 have been amended. Claim 2 and 9-16 have been canceled without prejudice. Claims 3-5 and 8 have been withdrawn. Claims 1, 6 and 7 are pending for the Examiner's consideration.

Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections, in light of the foregoing amendments and following remarks.

The specification has been amended on page 23, paragraph 44 to correct the definition of aralkyl. No new matter is added.

Claims 1, 6 and 7 have been amended to remove non-elected subject matter and to comport with the Examiner's suggestions as to allowable subject matter. No new matter is added. For the reasons that follow, Applicants believe all claims are in condition for allowance.

Obviousness-Type Double Patenting

Claims 1, 2, 6 and 7 were rejected under the judicially created doctrine of non-statutory obviousness-type double patenting over claims 1-3 and 14 of copending Application No. 10/845,586 for the reasons set forth on pages 4-5 of the Office Action. Claim 2 has been canceled. Therefore, the rejection as it pertains to claim 2 is moot.

Because the rejection was made over a copending patent application, the rejection is only a "provisional" obviousness-type double patenting rejection. The Examiner has correctly pointed this fact out on page 5 of the office action. Section 804 I.B of the MPEP states that "[i]f the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent." Since copending Application No. 10/845,586 has not issued as a patent, then the Applicants respectfully submit that if all of the rejections have been over come by this response that the Examiner should withdraw the obviousness-type double patenting rejection and allow the application to issue as a patent.

Withdrawal of the rejection as it pertains to claims 1, 6 and 7 is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 6 and 7 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on pages 6-10 of the Office Action. The Examiner has rejected claims 6 and 7 because the recite the term "prodrug". The Applicants have amended claims 6 and 7 to delete the word "prodrug". The rejection is moot.

Accordingly, withdrawal of the rejection of claims 6 and 7 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth on pages 11-12 of the Office Action. The Examiner has rejected claims 1 and 2 because the terms “protected hydroxy” and “aralkyl” are allegedly indefinite, and because the limitation “n=0, 1, 2 or 3” allegedly has no antecedent basis. The Applicants have amended claims 6 and 7 to overcome the rejection.

The term “protected hydroxy” has been deleted from claims 1 and 2. Therefore, the rejection is moot. Withdrawal of the rejection as it pertains to the term “protected hydroxy” is respectfully requested.

The Examiner has also made the rejection because the definition of “aralkyl” is allegedly unclear. The Examiner has stated that because the definition of “aralkyl” in the specification includes “styryl”, which the Examiner characterized as an arylalkenyl group, the term is sufficiently unclear to warrant a rejection. The Examiner bases his reasoning on one of skill in the art not understanding the meaning of “aralkyl” in the claims based on the definition in the specification. While the Applicants respectfully disagree and contend that the meaning and scope of “aralkyl” would be clear to one of ordinary skill in the art based on the definition provided in the specification, in the interest of rapid prosecution of the present application, the Applicant’s have amended the specification to remove the term “styryl” from the definition of “aralkyl”. The Applicants respectfully submit that because the definition of “aralkyl” no longer contains the offending term which the Examiner has objected to as creating an unclear definition scope, it would be clear to one of ordinary skill in the art that the term “aralkyl” clearly embraces an aryl group bonded to an alkyl moiety.

Accordingly, withdrawal of the rejection over the term “aralkyl” is respectfully requested.

The Examiner has also made the rejection because the limitation “n=0, 1, 2 or 3” allegedly has no antecedent basis. The Applicants point out that the group $-(CH_2)_nC(O)NR_7R_8$ in the definition of R_3 and R_4 of claim 1 does in fact contain the variable n. However, because claim 1 has been amended to require R_3 and R_4 to be H, and claim 2 has been canceled, the rejection is moot.

Accordingly, withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Claims 6 and 7 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth on page 12 of the Office Action. The Examiner has rejected claims 6 and 7 because they contain the term “prodrug”. Claims 6 and 7 have been amended to delete the term “prodrug”. Accordingly, the rejection as it pertains to claims 6 and 7 is moot. Withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Paruch et al., U.S. Patent No. 6,919,341 ('341) for the reasons set forth on pages 6-8 of the Office Action. The Examiner has indicated on page 16 of the office action that claims wherein one of R₁ and R₂ is cyclopropyl, R₃ and R₄ are H, and R₅ is phenyl, optionally substituted as defined, would be allowable if the other rejections were overcome.

Claim 2 has been canceled without prejudice. Accordingly, the rejection is moot as it pertains to claim 2. Claim 1 has been amended according to the Examiner's suggestion as to what subject matter is allowable. Accordingly, the rejection as it pertains to claim 1 is obviated by the amendment.

Withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Declaration

The Examiner has objected to the oath and declaration as being defective. The Examiner has objected to the oath and declaration because co-inventor Ping Huang made an undated or uninitialed change to her citizenship. The Examiner required a new oath and declaration.

Section 603 of the MPEP states that where "[a]n application was filed with a declaration under 37 CFR 1.63 executed by inventors A, B and C. If it is later determined that the citizenship of inventor C was in error, a supplemental declaration identifying inventors A, B and C may be signed by inventor C alone correcting C's citizenship." The Applicants submit herewith a new declaration identifying all of the inventors and signed by coinventor Ping Huang. The Applicants respectfully submit that the new declaration overcomes the Examiner's objection.

Conclusion

Applicants believe all claims are in condition for allowance. Early Notice of Allowance is respectfully requested. Should there be any issues that have not been addressed to the Examiners satisfaction; Applicants invite the Examiner to contact the undersigned attorney.

If any fees other than those submitted herewith are due in connection with this response, including the fee for any required extension of time (for which Applicants hereby petition), please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

Date: June 12, 2006

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